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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,838	03/26/2004	Blayn W. Beenau	70655.0200	2837
20322	7590	08/08/2005	EXAMINER WALSH, DANIEL I	
SNELL & WILMER ONE ARIZONA CENTER 400 EAST VAN BUREN PHOENIX, AZ 850040001			ART UNIT 2876	
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DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/708,838

Applicant(s)

BEENAU ET AL.

Examiner

Daniel I. Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ✓ 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ✓ 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3-04, 4-04.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### DETAILED ACTION

1. Receipt is acknowledged of the IDS received on 26 March 2004 and 9 April 2004.

#### *Double Patenting*

2. Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/710,331.
3. Although the conflicting claims are not identical, they are not patentably distinct from each other because the Applications all deal with verifying a biometric to authorize a transaction. Though the '331 Patent Application deals with smartcards, the Examiner notes that it is well known and conventional that the differences between smart cards, transponders, and other wireless/portable devices are obvious to one of ordinary skill in the art, and their selection for use is a matter of design/system constraints (cost, distance of communication, portability, convenience, etc.), for example.

For instance:

In claim 1 of the present claimed invention and claim 1 of the '331 Patent Application the Applicants claim:

i) "...transponder-reader system... proffered biometric ...database configured to store data packet..." (see claim 1), whereas in the '331 Patent Application the Applicants claim "...smartcard system... proffered biometric ...database configured to store data packet..." (see claim 1).

In claim 2 of the present claimed invention and claim 2 of the '331 Patent Application the Applicants claim:

ii) "...verify said proffered biometric sample." (see claim 2), whereas in the '331 Patent Application the Applicants claim "...verify said proffered biometric sample." (see claim 2).

In claim 3 of the present claimed invention and claim 3 of the '331 Patent Application the Applicants claim:

iii) "...associate said proffered biometric sample...loyalty point information." (see claim 3), whereas in the '331 Patent Application the Applicants claim "...associate said proffered biometric sample...loyalty point information." (see claim 3).

In claim 4 of the present claimed invention and claim 4 of the '331 Patent Application the Applicants claim:

iv) "...different biometric samples associated...loyalty point information." (see claim 4), whereas in the in '331 Patent Application the Applicants claim "...different biometric samples associated...loyalty point information." (see claim 4).

In claim 5 of the present claimed invention and claim 5 of the '331 Patent Application the Applicants claim:

v) "...database...data packets...criminal information." (see claim 5), whereas in the '331

Patent Application the Applicants claim "...database...data packets...criminal information." (see claim 5).

In claim 6 of the present claimed invention and claim 6 of the '331 Patent Application the Applicants claim:

vi) "...transponder-reader system." (see claim 6), whereas in the '331 Patent Application the Applicants claim "...smartcard system." (see claim 6).

In claim 7 of the present claimed invention and claim 7 of the '331 Patent Application the Applicants claim:

vii) "...authorized sample receiver." (see claim 7), whereas in the '331 Patent Application the Applicants claim "...authorized sample receiver." (see claim 7).

In claim 8 of the present claimed invention and claim 8 of the '331 Patent Application, the Applicants claim:

viii) "...primarily associate...secondarily associate...first user information." (see claim 8), whereas in the '331 Patent Application the Applicants claim "...primarily associate...secondarily associate...first user information." (see claim 8).

In claim 9 of the present claimed invention and claim 9 of the '331 Patent Application the Applicants claim:

ix) "...associate a second proffered biometric sample...loyalty point information." (see claim 9), whereas in the '331 Patent Application the Applicants claim "...associate a second proffered biometric sample...loyalty point information." (see claim 9).

In claim 10 of the present claimed invention and claim 10 of the '331 Patent Application the Applicants claim:

x) "...first proffered biometric sample...first user information...second biometric sample...second user information...different that said first user information." (see claim 10), whereas in the '331 Patent Application the Applicants claim "...first proffered biometric sample...first user information...second biometric sample...second user information...different that said first user information." (see claim 10).

In claim 11 of the present claimed invention and claim 11 of the '331 Patent Application the Applicants claim:

xi) "...associated with different user information." (see claim 11), whereas in the '331 Patent Application the Applicants claim "...associated with different user information." (see claim 11).

In claim 12 of the present claimed invention and claim 12 of the '331 Patent Application the Applicants claim:

xii) "...secondary security procedure..." (see claim 12), whereas in the '331 Patent Application the Applicants claim "...secondary security procedure..." (see claim 12).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black (US 2005/0122209).

Re claim 1, Black teaches a method for registering biometric information for use with a transponder-reader system, the system comprising: a biometric sensor configured to detect a proffered biometric sample; a device configured to associate the proffered biometric sample with

user information and transponder information to create a data packet; and a database configured to store the data packet, wherein the database is configured to communicate with the system (FIG. 1A-1D, 5A, abstract, which teaches proffering a biometric sample and associating the information with user and transponder information to create a data packet FIG. 10A-11B, 14A, 14B.) The Examiner notes that though some embodiments of Black are described in relation to a smartcard, Black has stated in the abstract that the teachings can be of a transponder, smartcard, card, etc. Black also teaches that the data can be stored on a host computer or on the transponder itself (paragraph [0090]+), based on security concerns. Though silent to a database, the Examiner notes it would have been obvious to one of ordinary skill in the art to store the data packet (user information and related transponder information) on a database (as it has been discussed above that the data can be stored locally or remotely) as a well-known and conventional means of storing data to be accessed quickly and efficiently.

Re claim 2, the Examiner notes that Black teaches that the biometric sample is stored (either on the transponder or not on the transponder), as discussed above. Accordingly, it is obvious to one of ordinary skill that once a sample it is processed in order so that it can be stored, read, etc. as is conventional in the art. Though silent to verification, the Examiner notes that it is obvious to verify a received sample in order to confirm that a complete and accurate sample was received, before storing, so that only a legitimate/complete sample is recorded (see FIG. 5A which teaches making sure that sample is acceptable, which can be interpreted as a verification).

Re claim 3, Black teaches associating of the biometric sample with at least one of personal information, credit card information, debit card information, savings account



information, membership information, PayPal account information, Western Union Account information, electronic bill payment information, automatic bill payment information, and loyalty point information. (FIG. 5A)

Re claim 5, it has been discussed above that at least one of proffered biometric samples, registered biometric samples, user information, terrorist information, and criminal information are stored in the data packets on the database.

Re claim 6, it has been discussed above that the database is contained in at least one of the transponder, transponder reader, sensor, remote server, merchant server, and transponder-reader system. Additionally, the Examiner notes that is an obvious matter of security, where the database is to be stored, and that choosing the location of the database is an obvious expedient well within the skill in the art, for security concerns, or due to system/design constraints.

Re claim 7, as the remote database has been taught above, capable of being on the host computer that is interpreted as being operated by an authorized sample receiver.

3. Claims 4 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black in view of Maritzen et al. (US 2002/0191816).

Re claim 4, the teachings of Black have been discussed above.

Black is silent to different proffered biometric samples being associated with a different one of personal information, credit card information, debit card information, savings account information, membership information, PayPal account information, Western Union Account information, electronic bill payment information, automatic bill payment information, and loyalty point information.

Maritzen et al. teaches such limitations (paragraph [0074]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of Maritzen et al.

One would have been motivated to do this to have additional accounts protected with biometric security for convenience of the user. The Examiner notes that such modification is an obvious expedient as it is well known and conventional that biometrics can be used to authenticate users for accounts/transactions, and that by providing different biometrics for different accounts is an obvious expedient for the convenience of the user.

Re claims 9-11, the teachings of Black have been discussed above.

Black is silent to associating a first proffered biometric sample with first user information and associates a second proffered biometric sample with second user information, different from first user information.

The teachings of Maritzen et al. have been discussed above including associating different biometric samples with different user information/accounts (see claim 4 above).

At the time the invention was made it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Black with those of Maritzen et al.

One would have been motivated to do this to provide additional biometric security for other accounts, providing user convenience, when performing a transaction, for example.

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Black in view of Moebs et al. (US 2005/0065872).

Re claim 8, the teachings of Black have been discussed above. Re claim 8, FIG. 10A-11B teach the biometric sample is primarily associated with at least one of a first user information (account number).

Black is silent to the biometric sample being secondarily associated with a second user information, different from the first.

Moebs et al. teaches that a customer can avoid overdrafts by preauthorizing the financial institution to tie the customer's checking account to one or more of the customers other accounts such as deposit accounts (paragraph [0017]). The Examiner notes that overdraft protection is well known and conventional in the art. Accordingly, the Examiner notes it would have been obvious that by linking an overdraft account to a primary account that is associated with the sample, that the overdraft account is interpreted as being secondarily associated with the sample, for if the primary account is overdrawn, the secondary account is drawn upon.

One would have been motivated to combine the teachings of Black with those of Moebs, in order to provide overdraft protection for the convenience of the user. It is clear that such protection is desirable for financial transactions (whether with a fob, smartcard, or other portable storage medium designed for such purposes.)

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Black in view of Machida (US 2004/0131237).

Re claim 12, the teachings of Black have been discussed above. Black teaches that biometrics are verified as legible, but is silent to how such samples are verified.

The Examiner notes that it is well known and conventional in the art to verify fingerprints. Specifically, Machida teaches verifying fingers/prints as valid, by examining spacing of minutiae (see claim 1) to see if the print is a real finger.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of Machida.

One would have been motivated to do this to increase security by only allowing legitimate fingerprints to be accepted.

*Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Gokcebay (US 5,245,329), Dolphin (US 5,677,953), Meadows et al. (US 5,869,822), Dunn et al. (US 5,987,155), Gray (US 6,268,788), Pare et al. (US 6,269,348), Takhar (US 2001/0053239), Iannacci (US 2002/0062249), Kawan (US 2002/0062284), Segal et al. (US 2002/0066784), Doyle et al. (US 2002/0095587), Janiak et al. (US 2002/0097142), Prokoski et al. (US 2002/0140542), Wang et al. (US 2002/0163421), Gravelle et al. (US 2002/178063), Simon (US 2003/0086591), Seifert (US 2003/0112120), Mitchell et al. (US 2003/0149661), Joseph (US 2003/0150911), Palmer et al. (US 2003/0266041), McCall et al. (US 2003/0229793), Hoffman et al. (US 2004/0020982), Koo (US 2004/0021552), Nugent (US 2004/0041021), Yamagishi (US 2004/0041690), Deyoe et al. (US 2004/0084542), Doughty et al. (US 2004/0133787), Zuili (US 2004/0149827), Royer et al. (US 2004/0155101), Lee (US 2004/0195314), Barillova et al. (US 2004/0199469), Golden et al. (US 2004/0208343), Kotzin (US 2004/0257196), Doughty et al (US 2005/0001711), Haala (US 2005/0005172), Ikeda et al. (US 2005/0018658), Inabe (US 2005/0033992), Rothschild et al. (US 2005/0054438), Gotfried et al. (US 2005/0087597), Kuwana et al. (US 2005/0091325), Haala (US 2005/0102524), and Arnouse (US 2005/0139669).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

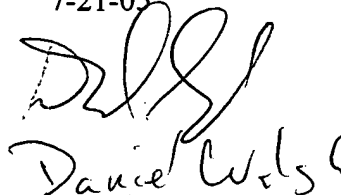
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Daniel I Walsh

Examiner

Art Unit 2876

7-21-05



Daniel I Walsh